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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,526	09/24/2001	Michael P. Spratt	1509-221	5271

7590 06/24/2005  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/960,526

Applicant(s)

SPRATT, MICHAEL P.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### **Election/Restrictions**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 14, drawn to a method of selecting categorized content items deriving a category-based preference based on detecting positive usage events and negative usage events with controller, classified in class 725, subclass 26.
- II. Claims 15 – 21, drawn to a mobile device, classified in class 705, and subclass 27.
- III. Claims 28 - 39, drawn to a method of selecting categorized content items with at least steps b and c being effected off the device, classified in class 725, subclass 26.

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group I has a different function for a method of selecting categorized content items deriving a category-based preference based on detecting positive usage events and negative usage events with controller. Claim 1 for example, does not require a mobile device without a controller in order to impart patentable distinction to the method recited therein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions Group I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions Group I has a different function regarding a method of selecting categorized content items deriving a category-based preference based on detecting positive usage events and negative usage events with controller. Claim 1 for example, does not require a method of selecting categorized content items with at least steps b and c being effected off the device in order to impart patentable distinction to the method and system recited therein.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Inventions Group II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Group II has a different function regarding to a mobile device. Claim 15 for example, does not require to a method of selecting categorized content items with at least steps b and c being effected off the device in order to impart patentable distinction to the method recited therein.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to be completed must include an election of the invention to be examined.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Species*

***In the event the applicant elects Group I above, the applicant is further obligated to elect one among the following species as follows:***

This application contains claims directed to the following patentably distinct species of the claimed invention:

1a - Species of claims 2, 4 – 7, 8, 10 – 12, wherein the positive usage events include use to the end.

1b - Species of claims 2, 4 – 7, 8, 10 – 11 and 13, wherein the positive usage events include use to the end.

1c - Species of claims 2, 4 – 7, 8, 10 – 11 and 14, wherein the positive usage events include use to the end.

1d - Species of claims 2, 4 – 7, 9 and 10 – 12, wherein the positive usage events include use to the end.

1e - Species of claims 2, 4 – 7, 9, 10 – 11 and 13, wherein the positive usage events include use to the end.

1f - Species of claims 2, 4 – 7, 9, 10 – 11 and 14, wherein the positive usage events include use to the end.

2a - Species of claims 3 – 7, 8, and 10 – 12, wherein the positive usage events include the active indication.

2b - Species of claims 3 – 7, 8, 10 – 11 and 13, wherein the positive usage events include the active indication.

2c - Species of claims 3 – 7, 8, 10 – 11 and 14, wherein the positive usage events include the active indication.

2d - Species of claims 3 – 7; 9 and 10 – 12, wherein the positive usage events include the active indication.

2e - Species of claims 3 – 7, 9, 10 – 11 and 13, wherein the positive usage events include the active indication.

2f - Species of claims 3 – 7, 9, 10 – 11 and 14, wherein the positive usage events include the active indication.

***In the event the applicant elects Group II above, the applicant is further obligated to elect one among the following species as follows:***

This application contains claims directed to the following patentably distinct species of the claimed invention:

1a - Species of claims 16, 20, and 22, wherein the first arrangement comprises means for detecting the use to the end.

1b - Species of claims 16, 21, and 23, wherein the first arrangement comprises means for detecting the use to the end.

2a - Species of claims 17, 20 and 22, wherein the first arrangement comprises means for detecting the selection of use.

2b - Species of claims 17, 21 and 23, wherein the first arrangement comprises means for detecting the selection of use.

3a - Species of claims 18, 20 and 22, wherein the first arrangement comprises means for detecting the selection for re-use.

3b - Species of claims 18, 21 and 23, wherein the first arrangement comprises means for detecting the selection for re-use.

4a - Species of claims 19, 20 and 22, wherein the first arrangement comprises means for detecting an active indication.

4b - Species of claims 19, 21 and 23, wherein the first arrangement comprises means for detecting an active indication.

***In the event the applicant elects Group III above, the applicant is further obligated to elect one among the following species as follows:***

This application contains claims directed to the following patentably distinct species of the claimed invention:

1a - Species of claims 25 and 28, wherein step (b) is effected at the device.

1b - Species of claims 25 and 29, wherein step (b) is effected at the device.

2a - Species of claims 26 and 28, wherein step (b) is effected at the source.

2b - Species of claims 26 and 29, wherein step (b) is effected at the source.

3a - Species of claims 27 and 28, wherein step (b) is effected off the device.



3b - Species of claims 27 and 29, wherein step (b) is effected off the device.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 is generic for Group I, Claim 14 is generic for Group II, and Claim 28 is generic for Group III.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 571.272.6761. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571.272.7159.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including

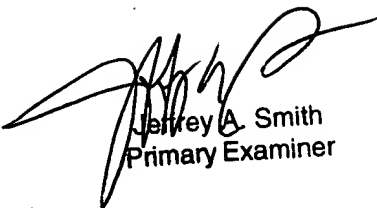
After Final communications labeled

"Box AF"]

(703) 746-7418 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

RER



Jeffrey A. Smith  
Primary Examiner